

REMARKS

Claims 1, 3-4, 8, 12-16, 19, 21, 23-24, 26, 29, and 139-163 are pending in the present application.

Claims 1 and 21 have been amended to delete the limitation “wherein the minoxidil or salt thereof is not encapsulated”.

Support for the amendments appears throughout the specification and claims as originally filed. No new matter has been added. Applicants, by amending any claims herein, make no admission as to the validity of any rejection made by the Examiner against any claim. Applicants reserve the right to reassert any of the claims canceled or the original claim scope of any claim amended herein, in a continuing application.

In view of the foregoing, further and favorable consideration is respectfully requested.

WRITTEN DESCRIPTION REJECTION

A. At page 3 of the Official Action, claims 1, 3-4, 8, 12-16, 19, 21, 23-24, 26, 29, and 139-163 have been rejected under 35 USC § 112, 1st paragraph as failing to comply with the written description requirement.

Regarding the rejection, the Examiner asserts that the language regarding "...that the minoxidil or salt thereof is not encapsulated" is new matter and is not supported by the instant specification and claims. While Applicants *strenuously* disagree with the Examiner's position, Applicants have deleted this language from claims 1 and 21 solely for the sake of compactness of prosecution.

In addition, the Examiner appears to assert that the limitation of minoxidil as the sole hair-growing active present in the composition is likewise not supported by the instant specification and is thus new matter. The Examiner specifically requests proof "that the specification clearly states and/or exemplifies that the inventors considered the limitation to be a part of the invention at the time of filing." In this regard, Applicants note that each of Examples 1 to 11 present in the instant specification relate to compositions containing minoxidil as the sole hair-growing active present. Accordingly, the specification clearly exemplifies that the inventors considered this to be a part of the invention at the time of filing, providing clear support for this limitation.

The remaining rejected claims depend either directly or indirectly from claims 1 and 21, and for this reason Applicants submit that the amendments have rendered

this rejection moot.

Withdrawal of this rejection is respectfully requested.

OBVIOUSNESS REJECTIONS

- A. At page 5 of the Office Action, claims 1, 3-4, 8, 12-16, 19, 26, 29, 139, 141, 143-144 and 162 are rejected as obvious over JP 10-265343 in view of Yu et al.***
- B. At page 8 of the Office Action, claims 21, 23-24, 146-151, 153-157, 159-160 and 163 are rejected as obvious over JP 10-265343 in view of Yu et al. and Chow et al.***
- C. At page 12 of the Office Action, claims 152 and 161 are rejected as obvious over JP 10-265343 in view of Yu et al. and Chow et al. and in further view of Uchikawa et al.***
- D. At page 12 of the Office Action, claims 140 and 145 are rejected as obvious over JP 10-265343 in view of Yu et al. and in further view of Uchikawa et al.***
- E. At page 13 of the Office Action, claim 158 is rejected as obvious over JP 10-265343 in view of Yu et al. and Chow et al. and in further view of Peck et al.***
- F. At page 14 of the Office Action, claim 142 is rejected as obvious over JP 10-265343 in view of Yu et al. and in further view of Peck et al.***

Applicants traverse each of these rejections. The primary reference for each of these rejections, JP 10-265343, does not constitute prior art against the instant application. The instant application has an effective priority date of April 22, 1998, as it properly claims priority to Australian Patent Application No. PP 3107 filed on April 22, 1998.

However, the effective date of the JP 10-265343 reference is the date the reference was published, October 6, 1998, which is clearly after the earliest claimed priority date of the present application. Further, Applicants note that the corresponding international publication of this reference, WO 98/32417, took place on July 30, 1998 in Japanese, again after the earliest claimed priority date of the present application. In addition, the WO 98/32417 publication does not bear a 35 USC 102(e) date against the present application since it (1) was filed and published before November 29, 1999 under the “old” 102(e); and (2) in any event, was not published in English. In fact, no document in this family of publications constitutes prior art against the instant application.

Accordingly, the primary reference relied on by the Examiner in each of these rejections, JP 10-265343, does not qualify as prior art against the present application. Without the teachings of this primary reference, none of the other cited reference teachings, whether taken alone or in combination, are sufficient to establish a case of *prima facie* obviousness against the present claims. Accordingly, withdrawal of each of the rejections under 35 U.S.C. §103(a) is requested.

CONCLUSION

Applicants assert that the claims are in condition for immediate allowance and early notice to that effect is earnestly solicited. Should the Examiner deem that any further action by Applicants' undersigned representative is desirable and/or necessary, the Examiner is invited to telephone the undersigned at the number set forth below.

In the event this paper is not timely filed, Applicants petition for an appropriate extension of time. Please charge any fee deficiency or credit any overpayment to Deposit Account No. 14-0112.

Respectfully submitted,

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